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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/552,424

07/05/2006

Jeff Chen

EX04-020C-US

6678

63572

7590

06/15/2010

MCDONNELL BOEHNEN HULBERT @ BERGHOFF LLP  
300 SOUTH WACKER DRIVE  
SUITE 3100  
CHICAGO, IL 60606

EXAMINER

JEAN-LOUIS, SAMIRA JM

ART UNIT

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1627

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/552,424	<b>Applicant(s)</b> CHEN ET AL.	
	<b>Examiner</b> SAMIRA JEAN-LOUIS	<b>Art Unit</b> 1627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 June 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-54 is/are pending in the application.
- 4a) Of the above claim(s) 27-54 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-26 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

**The Examiner for this current application at the USPTO has changed.**

**Examiner Jean-Louis can be reached at 571-270-3503.**

Claims 1-54 are currently pending in the application. However, claims 27-54 are currently withdrawn. Given that a lack of unity still exists among claims 1-26, a new restriction required is set forth below.

Applicant's election with traverse to various groups and species in the reply filed on 02/12/10 is acknowledged. The traversal is on the ground(s) that the claims relate to a single general inventive concept since a Markush claim is delineated and all of the compounds share common utility. This is not found persuasive because the claims recited in the instant application recite a multiplicity of species that lack a significant structural element. As a result, the claims do not render the invention related to a single general inventive concept and thus a lack of unity of invention exists. Moreover, given that these species contain various functional groups; their physical properties would differ from one another. Thus, in this instance, these species are patentably distinct and fully capable of supporting separate patents. As a result, the search would indeed be unduly extensive and burdensome given that a search for these species would consist of searching multiple databases for various references and literature searches.

Thus, the requirement dated 01/15/10 is still deemed proper and is therefore made FINAL.

Claims 27-54 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected groups and species, there being no allowable generic or linking claim. Claims 1-26 are therefore the sole claims under the new restriction requirement.

***Election/Restrictions***

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions, which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

I. Group I, claims 1-21 are drawn to a method for treating a kinase-dependent disease or condition comprising administering to a mammal in need of such treatment a therapeutically effective amount of a compound of formula I.

II. Group II, claims 22-23 are drawn to a method of treating diseases or disorders associated with uncontrolled, abnormal, and/or unwanted cellular activities, the method comprising administering, to a mammal in need thereof, a therapeutically effective amount of a composition comprising a compound to any claims 1-19.

III. Group III, claim 24 is drawn to a method of screening for a modulator of Tie-2, the method comprising combining a composition comprising the compound according to any claims 1-19 and at least one candidate agent and determining the effect of the candidate agent on the activity of Tie-2.

IV. Group IV, claim 25 is drawn to a method of inhibiting proliferative activity in a cell, the method comprising administering an effective amount of the compound according to any claims 1-19 to a cell or a plurality of cells.

V. Group V, claim 26 is drawn to a method of inhibiting Tie-2, the method comprising exposing either a natural or modified form of Tie-2 to a compound according to any claims 1-19.

The inventions listed as Groups I, II, III, IV, and V do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features.

An international application should relate to only one invention or, if there is more than one invention, the inclusion of those inventions in one international application is only permitted if all inventions are so linked as to form a single general inventive concept (PCT Rule 13.1). With respect to a group of inventions claimed in an international application, unity of invention exists only when there is a technical

relationship among the claimed inventions involving one or more of the same or corresponding special technical features.

The expression “special technical features” is defined in PCT Rule 13.2 as meaning those technical features that define a contribution which each of the inventions, considered as a whole, makes over the prior art. The determination is made on the contents of the claims as interpreted in light of the description and drawings. Whether or not any specific technical feature makes a “contribution” over the prior art, and therefore constitutes a “special technical feature”, should be considered with respect to novelty and inventive step.

In this instant application, the common technical feature in all groups is contrastingly different. Group I is directed to a method of treating kinase-dependent diseases or conditions while Group II is directed to a method of treating contrasting diseases associated with uncontrolled, abnormal, and/or unwanted cellular activities (i.e. the two groups are targeting different disease groups). Group III is directed to a method of screening for a modulator of Tie-2 while group IV is directed to a method of inhibiting proliferative activity in a cell. Group V however is directed to a method of inhibiting Tie-2, a protein known to be involved in angiogenesis, which is not necessarily a proliferative disorder. As a result, the examiner contends that such groups cannot be said to have a special technical feature under PCT Rule 13.2 because when considered as a whole, the claims focus on divergent methods.

As a result, no special technical features exist among the different groups because the inventions in Groups I, II, III, IV and V fail to make a contribution over the prior art with respect to novelty and inventive step. In conclusion, there is a lack of unity of inventions, and therefore restriction for examination purposes as indicated is proper.

### ***Species Election***

This application contains claims directed to more than one species of the generic invention. These species either possess divergent structures and/or materially different functions (i.e. kinase dependent diseases vs. disease associated with unwanted cellular activities) further supporting the notion that a lack of special technical feature exists among the aforementioned groups. Thus, these species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species listed below do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same special technical feature among the different species.

The species are as follows:

1) ***for Group I:***

- a) Applicant is required to elect a particular kinase-dependent disease or condition. Alternatively, applicant may elect a particular

disease out of the specification on pg. 50, paragraph 0122. Applicant is further cautioned to elect a **particular** disease and not just a generic category of diseases such as inflammation but rather the disease psoriasis, for example.

2) ***for Group II:***

a) Applicant is required to elect a particular disease or disorder associated with uncontrolled, abnormal, and/or unwanted cellular activities. Alternatively, applicant may elect a particular disease out of the specification on pg. 5, paragraph 0019 or pg. 51, paragraphs 0125. Applicant is further cautioned to elect a particular disease and not just a generic category of disease such as cancer but rather leukemia (i.e. cancer of the blood), for example.

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include



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all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

The following claims 1-26 are generic.

Applicant is also reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

No telephone call was made due to the complexity of the election/restriction.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samira Jean-Louis whose telephone number is 571-270-3503. The examiner can normally be reached on 7:30-5 PM EST M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/S. J. L. /

Examiner, Art Unit 1627

06/10/10

/SREENI PADMANABHAN/

Supervisory Patent Examiner, Art Unit 1627